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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,594	03/30/2004	Dylan S. Van Atta	005127.00356	5894
22910 7590 04/08/2008 BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601				
EXAMINER				
MORAN, KATHERINE M				
ART UNIT		PAPER NUMBER		
3765				
MAIL DATE		DELIVERY MODE		
04/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/814,594

**Applicant(s)**

VAN ATTA ET AL.

**Examiner**

Katherine Moran

**Art Unit**

3765

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 5-17 and 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s)    is/are allowed.
- 6) ☒ Claim(s) 1-4 and 18-21 is/are rejected.
- 7) ☐ Claim(s)    is/are objected to.
- 8) ☐ Claim(s)    are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No.   .
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other:
- Paper No(s)/Mail Date

**DETAILED ACTION**

***Response to Amendment***

Applicant's response of 8/6/07 has been received. The response amended claim

1. Claims 1-26 are pending, with claims 5-17 and 22-26 withdrawn as non-elected.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (U.S. 2,515,554). Freeman discloses the invention as claimed. Freeman teaches a swim cap comprising a first portion 16 configured to cover at least a portion of a crown of a user's head and having a first durometer. The cap further includes a second portion 10 formed of a flexibly and stretchy rubber material configured to conform tightly to and provide tension to keep the cap tight on a user's head, secured to the first portion and having a second durometer that is smaller than the first durometer. The second portion is configured to be in contact with and cover a substantial portion of a user's head during use and its outer peripheral portion has a thickness greater than a thickness of its inner portion as shown in Figure 1. The durometer of portion 16 is considered greater than that of the second portion because portion 16 is formed of stiffening ribs which assist in preserving the smooth contour of the second portion 10. A

portion which is stiffer is also harder than a stretchable rubber portion. The second portion entirely covers the first portion and extends beyond a peripheral edge of the first portion. Freeman teaches that the first portion 16 is on an inner surface of the second portion.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman '554 in view of Ewing et al. (Ewing, U.S. 2002/0184699). Freeman discloses the invention substantially as claimed. However, Freeman doesn't teach a first portion formed of PETg. Ewing teaches a plastic portion formed from PETg and teaches that PETg has excellent impact strength and durability. These properties would serve well as stiffener portions. Applicant's specification discloses that any relatively stiff, pliable material is suitable for the first portion, and further, does not provide criticality for employing one particular material over another, as long as the material has the desired properties. Therefore, it would have been obvious to form Freeman's first portion from PETg as taught by Ewing because this material would further improve the stiffening properties of Freeman's second portion.

5. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman '554 in view of Guadagnino, Jr. et al. (Guadagnino, U.S. 5,790,988). Freeman discloses the invention substantially as claimed. However, Freeman doesn't teach the second rubber portion formed of silicone. Guadagnino teaches a head covering 10 with a silicone coating 13. Silicone is known as a synthetic plastic rubber with superior resilience and water resistant properties and can be formed as a rigid or soft polymer. Applicant's specification teaches that any soft, flexible, stretchy material is deemed suitable for the second portion and any relatively stiff, pliable material is suitable for the first portion, and further, does not provide criticality for employing one particular material over another, as long as the material has the desired properties. Therefore, it would have been obvious to form Freeman's first or second portion from silicone in order to provide improved water-resistant and resiliency properties.
6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman '554 in view of Gregg (U.S. 3,979,777). Freeman discloses the invention substantially as claimed. However, Freeman doesn't teach the second portion is formed from latex. Gregg teaches a helmet with a second portion formed from latex rubber to more closely conform to the contours of a wearer's head. Applicant's specification teaches that any soft, flexible, stretchy material is deemed suitable for the second portion and does not provide criticality for employing one particular material over another as long as the material has the desired properties. Therefore, it would have been obvious to form Freeman's second portion from latex in order to provide improved water-resistant properties to the second portion.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-4 and 18-21 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendments to claim 1.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch, may be reached at (571) 272-4996. The official and after final fax number for the organization where this application is assigned is (571) 273-8300. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Katherine Moran/

Primary Examiner, AU 3765